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Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William Aichast

Serial No. 75/803,464

Robert T. Johnson, Jr., Sana Hakim and Andrea K. Cannon of
Bell Boyd & Lloyd LLC for William Aichast.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Hanak and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

William Aichast has filed an application to register
SANTA FE SPEEDWAY for "T-shirts and sweatshirts."¹

The Trademark Examining Attorney refused registration on
the ground that this proposed mark as a whole, if applied to
the goods, would be primarily geographically deceptively
misdescriptive of the applicant's shirts, and is thereby
barred from registration by Section 2(e)(3) of the Trademark
Act, 15 U.S.C. §1052(e)(3).

¹ Application Serial No. 75/803,464, filed on September 20, 1999,
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce on the goods listed in Int. Cl. 25.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

We affirm the refusal to register.

In order to establish a *prima facie* case for refusal of registration under Section 2(e)(3), the Trademark Examining Attorney must show that prospective purchasers of the goods would believe that the goods for which the mark is sought to be registered originate in the geographic place named in the mark when, in fact, the goods do not originate in that geographic place. See In re Wada, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) [NEW YORK WAYS GALLERY for various types of bags, backpacks, purses, etc., not from New York was held unregistrable under Section 2(e)(3)], and In re Loew's Theaters, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) [DURANGO held unregistrable for chewing tobacco not from Mexico].

The Trademark Examining Attorney argues that applicant's mark is barred from registration because the primary significance of applicant's mark as a whole is the geographic place, Santa Fe, New Mexico. In support of this portion of his *prima facie* case, the Trademark Examining Attorney offered evidence to show that the city of Santa Fe, New Mexico, is a place that is neither obscure nor remote. In particular, the

Trademark Examining Attorney introduced listings for "Santa Fe" from The American Places Dictionary (1994) and Merriam-Webster's Geographical Dictionary (3rd ed. 1997).

The Trademark Examining Attorney also argues that there is an association between the goods in applicant's application and the city of Santa Fe, New Mexico. In support of this portion of his *prima facie* case, the Trademark Examining Attorney has introduced evidence establishing that Santa Fe, New Mexico, is a major tourist center of the Southwest. Further, excerpts retrieved from the LEXIS/NEXIS® database contain statements about items of wearing apparel being designed, manufactured and sold in the city of Santa Fe.

Finally, applicant is located in Illinois, and there is nothing in the record to indicate that applicant's goods have their origin in, or are in any connection with, Santa Fe, New Mexico. In fact, in response to the Trademark Examining Attorney's specific inquiry, applicant concedes that its goods will have absolutely no connection with Santa Fe, New Mexico.

Both the Trademark Examining Attorney and applicant's counsel have agreed that Santa Fe is a city in New Mexico. However, while applicant does not contend that Santa Fe, the capital city of New Mexico, is obscure or relatively unknown, he does argue that even the term "Santa Fe," taken alone, is not "*primarily* geographical." See 2 J.T. McCarthy, McCarthy

on Trademarks and Unfair Competition, §14.18 (4th Ed. 1999). Applicant argues that for many Americans, "Santa Fe" evokes images of the popular *Santa Fe Railroad*, having 33,500 miles of tracks covering twenty-eight states. Additionally, applicant argues that especially as applied to apparel, "Santa Fe" describes a certain regional motif or decorative style associated with Santa Fe's Native American and Spanish heritage.² See In re International Taste Inc., 53 USPQ2d 1604 (TTAB 2000) [Because "Hollywood" is also seen as a general reference to the entertainment industry, it is not primarily geographical in the mark "HOLLYWOOD FRIES with star design."]

We find the case before us distinguishable. While T-shirts and sweatshirts may be sold almost everywhere, it is much more likely that, for example, apparel emblazoned with the designation SANTA FE SPEEDWAY would be sold in, or would originate from, Santa Fe, New Mexico, than elsewhere. In short, we agree with the Trademark Examining Attorney's assessment of this case. Because applicant's mark includes

² This is an Intent-to-Use application, so we have no specimens (e.g., photographs of the front of actual T-shirts) showing us the exact motifs applicant intends to use in an actual marketing context. Arguably, to the extent the artwork, material composition or styling of the shirts were to evoke southwestern traditions, it would merely reinforce the geographic significance of the city of Santa Fe. On the other hand, to the extent that the shirts were to show, for example, pictures of motorcyclists racing around a dirt track, it would do nothing to reinforce this contention about the term "Santa Fe" representing a regional style.

the term "Santa Fe," consumers would make the association with Santa Fe, New Mexico.

Applicant and the Trademark Examining Attorney also disagree over the significance of the additional, arbitrary term SPEEDWAY within the composite marks. The Trademark Examining Attorney argues that the presence of this term does not create a composite having a non-geographic connotation.

Contrariwise, applicant takes the position that the word SPEEDWAY takes the mark as a whole out of being "the name of a place known generally to the public." To rebut the Trademark Examining Attorney's *prima facie* case, applicant contends that its mark SANTA FE SPEEDWAY is not, when considered in its entirety, the name of a geographic place.

The mark SANTA FE SPEEDWAY, when analyzed as a whole, is not primarily geographically deceptively misdescriptive because 'Santa Fe Speedway' does not connote a specific geographic place to reasonable consumers.

(Applicant's reply brief, p. 3).

Further, applicant argues that the Trademark Examining Attorney has violated the anti-dissection rule, giving too little weight to SPEEDWAY - a totally arbitrary component of this mark.

The Trademark Examining Attorney acknowledges that the entire mark is more than the name of New Mexico's capital city. However, the Trademark Examining Attorney argues that

the overall impression of applicant's mark does not detract from the geographic significance of the word "Santa Fe" contained within the mark. According to the Trademark Examining Attorney, the mark as a whole still emphasizes that applicant's goods have their origin in the city of Santa Fe, New Mexico.

The word "speedway" suggests the existence of an actual motor speedway, and further suggests that these shirts are collateral goods sponsored by the motor speedway under that name. Nonetheless, adding the word "speedway" to the place name "Santa Fe" does not overcome the primarily geographic significance of the mark as a whole. Rather, the geographic significance of the mark remains.

In this regard, the Trademark Examining Attorney has shown that the DAYTONA INTERNATIONAL SPEEDWAY is located in Daytona Beach, the INDIANAPOLIS MOTOR SPEEDWAY is located in Indianapolis, the ATLANTA MOTOR SPEEDWAY is located in Atlanta, etc. Hence, it would be reasonable for prospective consumers to assume that the SANTA FE SPEEDWAY is located in Santa Fe.

In short, we find the term SPEEDWAY that applicant has added to the SANTA FE designation, though arbitrary in relation to clothing items, nonetheless tends to reinforce, not to detract from, the primary geographical connotations of

the mark, considered in its entirety. Applicant simply has not provided any facts as to why - provided we find SANTA FE alone to be primarily geographical - the primary geographic significance of the composite mark is lost by the addition of this term. Certainly, the determination of registrability under Section 2(e)(3) of the Lanham Act should not depend upon whether a composite mark is or is not unitary. In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986). See also In re Nantucket Inc., *supra*, at 893, n. 7; and In re Handler Fenton Westerns, Inc., 214 USPQ 448 (TTAB 1982).

As Professor McCarthy has observed, "[i]f the composite mark contains the name of the geographic location from which the goods do not come, a court may be more strict in its scrutiny... ." 2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §14:11 (4th ed. 1998). In the Wada case, this Board adopted just such an approach, and faulted the applicant therein for not providing "any facts as to why, in its view, the primary geographic significance of the mark is lost" by the addition of even arguably arbitrary words. See In re Wada, 48 USPQ2d 1689, 1690 (TTAB 1998).

Applicant argues, moreover, that when the word "SPEEDWAY" is added to the words "SANTA FE," this composite mark, if it has any meaning at all to members of the public, will evoke images of a former race track in Chicago. We agree that the

mark clearly suggests a connection to motor sports. However, we find that most consumers would likely be misled into thinking that the shirt is from New Mexico, and specifically a motor speedway in the Santa Fe area. On the other hand, it is not incumbent upon the Trademark Examining Attorney to prove that Santa Fe, New Mexico, has, or does not have, any racing in the general area, or that Santa Fe has, or does not have, an actual attraction known as the "Santa Fe Speedway."³

Conversely, applicant, a resident of Chicago, may find a market in the Midwest by tapping into nostalgia over a now defunct clay track for motorcycles and stock cars. However, that does not change the result herein. It would be relevant to our determination herein if the record showed that a substantial portion of the American population was aware of the actual Santa Fe Speedway - a dirt track that has been closed for years. If the record showed that this Chicago area track had once been nationally famous and that these shirts represented some kind of commemorative clothing for that once famous track, then it would be obvious to prospective

³ Again, because this is an Intent-to-Use application, we cannot be sure exactly how consumer will see this mark in context. However, on its face, there is nothing inherently incongruous about SANTA FE SPEEDWAY, nor do we know of any reason why the potential consumer would view this entire composite as a joke. Cf. In re Sharky's Drygoods Co., 23 USPQ2d 1061 (TTAB 1992) ["PARIS BEACH CLUB" would be viewed as a humorous mark and hence not primarily geographical given the facetious juxtaposition of "Paris" with "Beach Club."].

purchasers that the Santa Fe Speedway had nothing to do with New Mexico. However, that is not the case herein.

We turn next to the requirement that, for a refusal of registration under Section 2(e)(3), there must be a goods/place association. The Trademark Examining Attorney argues that the public is likely to believe that applicant's goods come from Santa Fe, New Mexico. He has placed evidence into the record of this application to demonstrate that Santa Fe is home to several clothing designers who work there. Additionally, some of these designers sell their decorative wardrobe items at retail within the city of Santa Fe. Some of these items of apparel may well be similar to the goods in this application:

... A number of the items highlighted in the cowboy category are apparel pieces designed by Jane Smith, whom Devorik described as the Nan Kempner of Santa Fe... . ("Fashion on the Web," Womens Wear Daily, p. 8, November 9, 1999)

Santa Fe clothing designer Norika Ferry will present traditional fujimusume dance and teach the art of kirigami... . ("Eastern Exposure." The Santa Fe New Mexican, p. P-32, April 2, 1999)

A New York television producer is to start filming a travel program Friday and *Travel & Leisure* magazine will feature a prominent Santa Fe based clothing designer in a cover story in October... . ("Hot, Hot, Hot: Santa Fe is back in style," The Santa Fe New Mexican, p. A-1, July 9, 1998)

While in Santa Fe, Wilson began to make her mark as a fashion designer, ushering Southwestern style into the high-fashion world. Her designs were wholesaled to Saks Fifth Avenue and I. Magnum department stores. She opened La Boutique in Santa Fe to sell her apparel... . "Literary, fashion figure Elita Wilson dies," The Santa Fe New Mexican, p. B-2, April 9, 1996)

If you were to ask Judy Broughton what her secret for success is, she'd tell you it's "showing up every day, being consistent, working hard and having a love for clothing and design." Broughton has been in the clothing business in Santa Fe for 20 years... . "Chit chat, kindness and unique clothes bring them in," The Santa Fe New Mexican, Special Sections, p. 17, April 7, 1996)

Gossamer Wings is a high-end clothing manufacturer that until February of 1995 also had a retail store in downtown Santa Fe. The lawsuit also claims Grimes failed to make payment ... on a promissory note she signed for tenant improvements on the factory space she leased in southwest Santa Fe... . "High-end clothing manufacturer sued over downtown store lease," The Santa Fe New Mexican, p. B-3, January 12, 1996)

Because of this, the Trademark Examining Attorney argues that the city of Santa Fe will be associated with applicant's goods.

The Trademark Examining Attorney is not required to "marshal evidence that the place named is noted for or famous for the goods recited in the application but, rather, ... must make a persuasive case that, on seeing the mark, purchasers would be deceived into believing that the goods came from the

place named in the mark." In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849 (TTAB 1982). We believe consumers will perceive an association between applicant's goods and Santa Fe. It is sufficient for the Trademark Examining Attorney's refusal of registration if consumers would believe the goods are manufactured in the places named in applicant's marks. Having established that several prominent designers and manufacturers are working out of Santa Fe, the Trademark Examining Attorney has made out a *prima facie* case on this matter with evidence showing that the goods in question emanated from, or were sold in, the place named by the mark. No more can be expected from the Office in the way of proof. In re Loew's Theaters, Inc., *supra* at 869.

Furthermore, the question is not only whether consumers would perceive that applicant's shirts are manufactured in the place named, but alternatively whether they would perceive some other type of connection or relationship with the place named. See, e.g., In re Olin Corp., 181 USPQ 182 (TTAB 1973) ["The 'ornamentation' of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source ..."]. Hence, it is sufficient if the record shows that consumers would believe the goods were manufactured as collateral products for businesses located in Santa Fe.

The Trademark Examining Attorney has pointed out that Santa Fe is a major metropolitan area. See Nantucket, *supra*, Nies J., concurring, 213 USPQ at 895-96 [CHICAGO for shirts would be protectable only upon the establishment of acquired distinctiveness]. The Trademark Examining Attorney has established that Santa Fe is a known tourist destination and that, to borrow a phrase, T-shirts and other such "souvenirs for the pilgrims of popular culture" are widely available in these places. Rock and Roll Hall of Fame and Museum Inc. v. Gentile Productions, 134 F.3d 749, 45 USPQ2d 1412, 1419 (6th Cir. 1998). Accordingly, as a large American city that is also a tourist destination, it is a given that T-shirts and sweatshirts emblazoned with "Santa Fe" alone, and "Santa Fe" followed immediately by other local designations (e.g., "Santa Fe Horse Park," "Santa Fe Children's Museum," or "Santa Fe Speedway"), would comprise a significant sales item for designer and name-brand outlets in Santa Fe.

In sum, based on the record before us in this appeal, we find that consumers encountering the mark SANTA FE SPEEDWAY on T-shirts would be likely to believe mistakenly that the shirts have their origin in Santa Fe or are otherwise connected with Santa Fe, New Mexico.

Decision: The refusal to register under Section 2(e)(3) of the Trademark Act is affirmed.